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CROWELL & MORING LLP
INTELLECTUAL PROPERTY GROUP
P.O. BOX 14300
WASHINGTON DC 20044-4300

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OFFICE OF PETITIONS

In re Application of :
Bachinger et al. : DECISION ON PETITION
Application No. 09/761,661 :
Filed: 18 January, 2001 :
Attorney Docket No. 1748X/49451 :
:

This is a decision on the petition filed on 13 October, 2004, under 37 CFR 1.137(b), to revive the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.137(b)." This is not a final agency decision.

The above-identified application became abandoned on 21 February, 2004, for failure to timely file a reply to the non-final Office action mailed on 20 November, 2003, which set a three (3) month shortened statutory period for reply. No extensions of the time for reply in accordance with 37 CFR 1.136(a) were obtained. Notice of Abandonment was mailed on 27 May, 2004.

The petition is accompanied by a declaration by Kerry B. Hillier, Manager of Intellectual Property for assignee Ballard Power Systems, Inc. (hereinafter "Ballard"). In his declaration, Mr. Hillier states, in pertinent part.

...

5. During January, 2004, in my capacity as Intellectual Property Counsel, I instructed (or

authorized others to instruct) Ballard's outside patent counsel to allow U.S. patent application Serial No. 09/761,661, of which Ballard is currently the record owner, to become abandoned, due to budgetary considerations for our intellectual property operations.

...

A grantable petition filed under the provisions of 37 CFR 1.137(b) must be accompanied by:

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof. In an application abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee.

(2) the petition fee as set forth in 37 CFR 1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and

(4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c)).

The present petition does not satisfy requirement (3) above. The statement of Mr. Hillier raises a question as to whether the entire delay in filing a petition under 37 CFR 1.137(b) was unintentional.¹ Where there is a question whether the delay was unintentional, the petitioner must meet the burden of establishing that the delay was unintentional within the meaning

¹See MPEP 711.03(c)(III)(D); See Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. at 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office at 86-87 (October 21, 1997).

of 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b).²

In the present petition, petitioner apparently asserts that the delay was unintentional due to petitioner Ballard's financial condition.

With regard to the "unintentional" delay standard:

Where the applicant deliberately permits an application to become abandoned (e.g., due to a conclusion that the claims are unpatentable, that a rejection in an Office action cannot be overcome, or that the invention lacks sufficient commercial value to justify continued prosecution), the abandonment of such application is considered to be a deliberately chosen course of action, and the resulting delay cannot be considered as "unintentional" within the meaning of [37 CFR] 1.137(b). . . . An intentional delay resulting from a deliberate course of action chosen by the applicant is not affected by: (1) the correctness of the applicant's (or applicant's representative's) decision to abandon the application or not to seek or persist in seeking revival of the application; (2) the correctness or propriety of a rejection, or other objection, requirement, or decision by the Office; or (3) the discovery of new information or evidence, or other change in circumstances subsequent to the abandonment or decision not to seek or persist in seeking revival.³

Here, the petition indicates that at least some of the discretionary funds that were available to petitioner Ballard in 2003 and 2004 were consciously and deliberately allocated to the prosecution and/or maintenance in force of other members of petitioner's domestic and foreign patent and trademark portfolios. While the petition does not indicate where and when such moneys were allocated, or the amounts, inspection of USPTO patent financial records for other patents assigned to Ballard indicate that in 2003 alone, petitioner was able to obtain or allocate \$1,345.00 toward the prosecution of Application No.

²See In re Application of G., 11 USPQ2d 1378, 1380 (Comm'r Pat. 1989).

³See Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 86 (October 21, 1997) (discussing the meaning of "unintentional" delay in the context of the revival of an abandoned application).

09/890,176 (now U.S. Patent No. 6,696,188), and \$1,639.00 toward the prosecution of Application No. 09/875,274 (now U.S. Patent No. 6,699,608). Thus, as petitioner was able to allocate to the prosecution of other patent applications in the USPTO more than enough fees to have continued prosecution of this application, petitioner clearly subordinated the prosecution of this patent application to the furtherance of the prosecution of other applications.

Notwithstanding what other currently undisclosed fees petitioner allocated to his domestic and foreign intellectual property pursuits, consideration of the delay arising from those fees known to have been deliberately diverted away from the prosecution of this patent application is inconsistent with a finding that the delay in prosecution of the above-identified application was unintentional. That is, as petitioner came to the conclusion that those fees were better spent elsewhere, in that the instant application did not warrant continued prosecution, the abandonment of this application is considered to be a deliberately chosen course of action, and the resulting delay in prosecution thereof cannot be considered as "unintentional" within the meaning of 35 U.S.C. § 41(c) and 37 CFR 1.137(b).⁴ Any renewed petition should include a chronological itemization of the fees paid to in pursuit of petitioner's intellectual property portfolio in 2003-2004, and an explanation if possible, as to why the deliberate allocation of this fees away from the instant application can reasonably be considered to be unintentional.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX: (703) 872-9306
Attn: Office of Petitions

⁴See In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pat. 1989); MPEP 711.03(c), Section III, subsection (C)(1).

By hand: Customer Service Window
Mail Stop Petition
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Telephone inquiries concerning this matter may be directed to the undersigned at (571)272-3231.

D. Wood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions